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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,754	09/28/2001	Yoshihiro Itoh	05905.0153	3110

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EXAMINER

LABAZE, EDWYN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,754

Applicant(s)

ITOH ET AL.

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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**DETAILED ACTION**

1. Receipt is acknowledged of amendments filed on 2/21/2003.
2. Claims 26-41 are presented for examination.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 26-28, 32-33, and 37-41 are rejected under 35 U.S.C. 102(b) as being unpatented by Newman et al. (U.S. 5,665,951).

Re claims 26, 32, 37, 39, 40, and 41: Newman et al. discloses customer indicia storage and utilization system, which includes a personal database for registering the user's personal information sent from the communication terminal (col.6, lines 58+; col.7, lines 1+); means for creating an enciphered bar code by presenting the user's tastes according to the user's personal information registered in the personal database (the examiner is broadly interpreted the user's tastes as the user's wardrobe contents including color and style) and by specifying certain service content that suits the user's tastes (col.3, lines 48-67 and col.4, lines 1+); means for delivering image data (col.3, lines 40+), including the bar code, to the user' communication terminal 51 (col.7, lines 18+), wherein the communication terminal comprises a storage means for the

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delivered image data and a displaying means for displaying the image data (col.7, lines 1+) and wherein an information processing terminal having a bar code reader reads, using its bar code, the bar code contained in the image data displayed on the display means of the communication terminal, recognizes the specific user and service content according to the bar code, executes the necessary processing to provide a service according to the service content, and sends new personal information generated by the service to the server so that the new personal information is reflected in the service content (col.4, lines 1+; col.5, lines 35+; col.6, lines 20+ and col.10, lines 34+), further comprising means for delivering image data/graphical rendering, including the bar code, to the communication terminal (col.3, lines 61-67 and col.4, lines 1+) and wherein the delivering comprising storing the delivered image data and displaying the image data (col.3, lines 16-46), also comprising of means for receiving (using communication link 53 between the store computer 52 and the customer's computer 51, See Fig. # 3 of Newman et al.) the delivered image (col.7, lines 1-45); means for storing the received image data (col.7, lines 48+); and means for displaying (via the user's monitor displaying means) the image data. Moreover, the examiner is broadly interpreted the "delivery means" as a method of transferring or transmitting one item from one place/station to another one (using wireless or wired coupled means). In the art and using processing system (computer), the Internet could be regarded as a delivery means (through a modem and/or wireless telecommunications). Also the use of IC/smart card 11 (See col.4, lines 15+ of Newman et al.) with a storage device, read/write unit could be considered as a "delivery means" wherein the user enters or registers all personal information and save onto the memory or storage area 13 (Fig. # 1 of Newman et al. and col.4, lines 55+) of the card and to be downloaded at point-of sale terminal or kiosk 12 as taught by Newman et al. Therefore, Newman et al.

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teaches a system, which includes a first delivery means for delivery means image data including the bar code (col.4, lines 1+), a second delivery means for delivery a specified (through link 53, See Fig. # 3 of Newman et al.), a first personal database 11 (col.4, lines 15+) and a second personal database 51 (col. 7, lines 31+).

Re claims 27, 33, 38: Newman et al. teaches a system, wherein the server 52 has a product information database for registering specified information according to a plurality of products (col.7, lines 18+); wherein the means for creating the bar code creates an enciphered bar code to specify the user according to the user's personal formation (col. col.3, lines48-67 and col.4, lines 1+); wherein the information processing terminal specifies the user by reading, using the bar code reader, the bar code displayed on the display means of the communication terminal, and specifies a product selected by the user among the plurality of products with their respective bar codes displayed thereon, by reading, using the bar code reader, the bar code on the product selected by the user, and sends the bar code of the selected product as information regarding a purchased product of the user (col.4, lines 1+; col.5, lines 35+; col.6, lines 20+ and col.10, lines 34+); wherein the server registers, in the personal database, the received information about the user's purchase product and presumes the user's tastes according to a purchase history of the user so that the presumption of the user's tastes is reflected in the service content for the next delivery (col.9, lines 14+); and wherein the purchase history (items already purchased or own) is registered in the personal database and comprises a list of purchased products registered in the personal database (col.9, lines 14-45).

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Re claim 28: Newman et al. teaches a system, which includes a machine readable storage medium (such as a floppy disc, CD-ROMs) having a program stored therein for causing a computer to download data (col.3, lines 61+).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-31, 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (U.S. 5,665,951).

The teachings of Newman et al. have been discussed above.

Newman et al. fails to disclose method to provide a better service rate/price or discount with regard to products having a high purchase frequency or most sold/purchased items by the user, method regarding products for which the seller wants to increase or decrease the price based on the user's purchased history.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Newman et al. a method to provide a better service rate/price or discount with regard to products having a high purchase frequency or most sold/purchased items by the user, method regarding products for which the seller wants to increase or decrease the price based on the user's purchased history in order to keep a good business customer relation with the user. Furthermore, such modification would involve the software program to correlate items from the outlet/store catalog with stored information on

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frequent items purchased by the user and related to the user's tastes so as to better rate/assess the user (in other words provide special discounts) on items with the intent of purchasing. Moreover, such modification would be advantageous to both the user by saving time (with no need to keep on looking on different stores) and money (from special rate/discount), guaranteeing product delivery, and to the store/seller by keeping a good flow of business and relationship with preferred customers. In addition, such modification would have been an obvious extension as taught by Newman et al.

### *Response to Arguments*

Applicant's arguments with regards to claims 26-41 filed on 2/21/2003 have been fully considered but are moot in view of the new ground (s) of rejection

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DiGiorgio et al. (U.S. 6,385,729) discloses secure token device access to services provided by an Internet service provider.

Revashetti et al. (U.S. 6,370,578) teaches active marketing based on client computer configurations.

Catan (U.S. 6,491,217) discloses machine-readable label reader system with versatile response selection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
May 23, 2003



KARL D. FRECH  
PRIMARY EXAMINER